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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,892	03/02/2004	Jeffrey A. McFadden	10005.001710	2681

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EXAMINER	
BOVEJA, NAMRATA	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/790,892	MCFADDEN ET AL.	
	Examiner	Art Unit	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *01/23/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 03/02/2004.

2. Claims 1-22 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5, 6, 9, 11-14, and 22, are rejected under 102(b) as being anticipated by Mason et al. (Patent Number 6,401,075 hereinafter Mason).

In reference to claims 1 and 11, Mason teaches a computer program product and method of optimizing an advertising campaign on a computer network, the method comprising: delivering an advertisement to a client computer over a computer network (col. 2 lines 6-13 and col. 4 lines 20-25); automatically measuring an efficacy of the advertisement to generate a result (col. 2 lines 6-17 and 39-45, col. 4 lines 20-57, and col. 6 lines 30-33); and automatically changing a characteristic of the advertisement based on the result (col. 2 lines 6-17, col. 4 lines 57-67, and col. 6 lines 36-59).

4. In reference to claim 2, Mason teaches the method wherein the computer network includes an Internet (col. 4 lines 9-19 and col. 5 lines 33 to col. 6 lines 65).

5. In reference to claims 3 and14, Mason teaches the computer program

product and method wherein the result is based at least on a click-through of the advertisement (col. 6 lines 36-51).

6. In reference to claims 5 and 12, Mason teaches the computer program product and method wherein the characteristic comprises a trigger on when the advertisement is to be displayed (col. 6 lines 54-59).

7. In reference to claims 6 and 13, Mason teaches the computer program product and method wherein the characteristic comprises an aesthetic feature of the advertisement (col. 6 lines 36-51).

8. In reference to claim 9, Mason teaches the method wherein the advertisement is displayed in the client computer when a web browser in the client computer is pointed to a particular website (col. 4 lines 25-37 and 57-67).

9. In reference to claims 22, Mason teaches a method of optimizing an advertising campaign, the method comprising: delivering a plurality of advertisements for a same product to a plurality of client computers (col. 4 lines 54-67 and col. 6 lines 33-36); receiving data from client programs running and stored in the client computers; determining an efficacy of each of the advertisements based on the received data (col. 4 lines 20-53 and col. 6 lines 36-59); and automatically selecting an advertisement for the product based on the efficacy of the advertisements (col. 4 lines 54-67 and col. 6 lines 36-59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 10, 16, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason.

In reference to claim 10, Mason teaches determining an efficacy of the first advertisement based at least on information including the end-user response to the first advertisement (col. 2 lines 6-17 and 39-45, col. 4 lines 20-57, and col. 6 lines 30-33). Mason is silent about receiving data from a client program running and stored in the client computer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to receiving data specifically from a client program running and stored in the client computer as an obvious matter of design choice. Since this information is required to determine which advertisements to show to the user, it can be determined by the central server or by using for examples cookies on user terminals to record click throughs locally as both of the computing systems would serve the same function and achieve the same result of determining for example a click through rate for a given advertisement.

11. In reference to claim 16, Mason teaches the a method of delivering advertisements over a computer network, the method comprising: delivering a first advertisement of an advertising campaign to a client computer (col. 2 lines 6-13 and col. 4 lines 20-25); receiving data being indicative of a user response to the first advertisement (col. 4 lines 20-53 and col. 6 lines 36-40); determining an

efficacy of the first advertisement based at least on information including the user response to the first advertisement (col. 2 lines 6-17 and 39-45, col. 4 lines 20-57, and col. 6 lines 30-33); and delivering a second advertisement of the advertising campaign to another client computer, the second advertisement being automatically selected based on the efficacy of the first advertisement (col. 2 lines 6-17, col. 4 lines 57-67, and col. 6 lines 36-59).

Mason is however silent about receiving data specifically from a client program running and stored in the client computer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to receiving data specifically from a client program running and stored in the client computer as an obvious matter of design choice. Since this information is required to determine which advertisements to show to the user, it can be determined by the central server or by using for examples cookies on user terminals to record click throughs locally as both of the computing systems would serve the same function and achieve the same result of determining for example a click through rate for a given advertisement.

12. In reference to claim 17, Mason teaches the computer program product and method wherein the result is based at least on a click-through of the advertisement (col. 6 lines 36-51).

13. In reference to claim 19, Mason teaches the method wherein the first advertisement is delivered over an Internet (col. 4 lines 54-67).

14. Claims 4, 7, 15, 18, 20, and 21 are rejected under U.S.C. 103(a) as being unpatentable over Mason in view of Official Notice.

In reference to claims 4, 15, and 18, Mason does not teach the computer program product and method wherein the efficacy relates to a conversion of the advertisement or the first advertisement. Official Notice is taken that it is old and well known to relate efficacy to a conversion of the advertisement or the first advertisement. For example, when a user clicks on a banner ad, the advertiser pays for that lead to the hosting company, and when the user subsequently makes a purchase from the advertiser's website, the advertiser pays the hosting company additional commission due to the resulting sale, since the advertiser completed a sale as a direct result of the user clicking on that advertisement. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to relate efficacy to a conversion of the advertisement or the first advertisement to enable the hosting company to earn additional revenues from resulting sales by the users who click on the advertisements, and furthermore, by presenting a second advertisement relating to the first advertisement that already resulted in a sale (i.e. cell phone accessories advertisement can be shown if the user just purchased a cell phone by clicking the link for a cell phone company advertisement), the hosting company is providing a very relevant advertisement to the user that has an increased potential in leading to an additional conversion, since the product directly relates to the previously purchased product.

15. In reference to claim 7, Mason does not teach the method wherein the aesthetic feature includes a presentation vehicle for displaying the advertisement. Official Notice is taken that it is old and well known to change the

presentation vehicle for displaying the advertisement. For example, advertisers who advertise on the Internet frequently change the presentations vehicles by displaying their product advertisement as a banner advertisement, as a pop-up advertisement, as a video, or as a picture within an article on a webpage as done by car manufacturers. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to use the aesthetic features of presentation vehicles to enable the advertisers to appeal to different users, to manage their budget by advertising in the more expensive presentation vehicles on some sites and in the less expensive presentation vehicles on the other sites, and to prevent the users from seeing the same format of the advertisement repeatedly.

16. In reference to claim 20, Mason teaches the method wherein the first advertisement and the second advertisement are for a same product (col. 3 lines 24-31, col. 4 lines 54-67, and col. 6 lines 36-51). Mason does not teach the method wherein the first and second advertisements are for the same products and have different presentation vehicles. Official Notice is taken that it is old and well known to change the presentation vehicle for displaying the advertisement. For example, advertisers who advertise on the Internet frequently change the presentations vehicles by displaying their product advertisement as a banner advertisement, as a pop-up advertisement, as a video, or as a picture within an article on a webpage as done by car manufacturers. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to use the aesthetic features of presentation vehicles to enable the advertisers to

appeal to different users, to manage their budget by advertising in the more expensive presentation vehicles on some sites and in the less expensive presentation vehicles on the other sites, and to prevent the users from seeing the same format of the advertisement repeatedly.

17. In reference to claim 21, Mason teaches the method wherein the first advertisement and the second advertisement are for a same product. Mason does not specifically teach the first and second advertisements for the same products having different processing triggers. Official Notice is taken that it is old and well known to have different processing triggers for two advertisements for the same product as done by advertisers on the Internet. For example, a car manufacturer may only want to pay to have 15,000 click throughs for a banner advertisement for a car, but the advertiser may only want to pay for having a video of the car for a time period of one hour on a specific day on a given site, since it might be more expensive to advertise using the video presentation medium on that particular website. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have different processing triggers for two advertisements for the same product to enable the advertisers to manage their budget by advertising in the more expensive presentation vehicles such as videos on some sites for a period of time and in the less expensive presentation vehicles such as banner advertisements on the other sites based on the number of click throughs.

18. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mason in view of the article titled, "Web ads get glitzy, savvy," by Richard

Tedesco that was published on November 8, 1999 in Broadcasting & Cable on page 49 (hereinafter Tedesco).

In reference to claim 8, Mason does not teach the method wherein the advertisement is displayed in a pop-up in the client computer. Tedesco teaches the method wherein the advertisement is displayed in a pop-up in the client computer (page 1 paragraphs 1, 7, and 12). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Mason to include providing advertisements displayed in a pop-up on the client computer to increase interactivity with the user while still giving the users the option to click off the advertisement, move it elsewhere on the screen, and even minimize the advertisement for later interaction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **FAX** number for the organization where this application or proceeding is assigned is **571-273-8300.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

August 15th, 2007